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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,332	07/01/2004	David S. Bonalle	70655.3000	4331

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EXAMINER	
WALSH, DANIEL I	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/710,332	BONALLE ET AL.	
	Examiner	Art Unit	
	Daniel I. Walsh	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16 and 18-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16 and 18-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the amendment received on 7-28-06.

Double Patenting

2. Claims 1 and 20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/710,307. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variants and of the same scope.

For example claims 1 and 3 of the '307 Application the Applicants claim "...smartcard...integrated circuit device...common file structure...partner file structure..." (re claim 1) and "...room key." (re claim 3), whereas in the current Patent Application the Applicants claim "...smartcards...integrated circuit device...common file structure...partner file structure..." (re claim 1) and "...room key." (re claim 20).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-7, 9-15, 18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as cited in the previous Office Action, in view of Hohle et al. (US 6,101,477).

Re claim 1, Black teaches receiving a proffered biometric sample at a sample receiver, receiving user information at the sample receiver (FIG. 1a, FIG. 5A, abstract); associating the biometric sample with user information to create a data packet (FIG. 10A-11, 14A). The user information is interpreted as a data packet that associates user information, biometric information. Though silent to associating smartcard information, the Examiner notes that it has been discussed in the previous Office Action that Black teaches that transponders and smartcards are possible embodiments of the invention. As Black teaches that the transponders have a unique identifier/customer number associated with the data (interpreted as packet (FIG. 10+ and 14+), it would have been obvious for the smartcard to have a unique customer number or serial number for identification purposes. Such unique identifying means server as a well-known and conventional means to identify and provide security of the system. Accordingly, it would have

been obvious to one of ordinary skill in the art to receive the unique identifier and associate it with a data packet as a means to authenticate and verify the smartcard.

Black is silent to associating the data package with at least one of a partner file structure and a common file structure, and the newly added limitations as claimed, relating to the file structures.

Hohle et al. teaches a biometric smart card system with such limitations (claim 1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Hohle et al.

One would have been motivated to do this in order to integrate additional functions in the system for user convenience/usability.

The Examiner notes that as the information is all stored on the card, it would be obvious that it's associated with the file structures in order to facilitate use of the card for the additional functionality of the users/cardholders.

Re claim 2, Black teaches contacting an authorized sample receiver through at least one of a computer, Internet, software, hardware, third party biometric entity, kiosk, biometric registration terminal, and communication device (FIG. 5A). It is clear that during reception of the sample that the receiver is in contact with one of the listed devices, in order to receive the sample.

Re claim 3, Black teaches that receiving of the sample includes at least one of processing, storing, comparing, and verifying the sample as a record is created (FIG. 14A). Additionally, the Examiner notes it would have been obvious to one of ordinary skill in the art to process/store/compare/verify the sample as such means are conventional in the art to authenticate

a sample (that is real), and put it into a format that can be recognized for accessing and verifying a user.

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (also see FIG. 10A-11B, FIG. 14A).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the transponder itself (paragraph [0090]), which is interpreted as being contained in at least one of a smartcard, a smartcard reader, a sensor, a remote server, a merchant server, and said smartcard system, as Black teaches that the invention can take form of a smartcard, transponder, other device (abstract for example). Though silent to a database, Black teaches remote or local storage. As a database is a well know and conventional means to store and organize data, its use would be an obvious expedient to store the data packet at one of the locations set forth, depending on the desired security, for example.

Re claim 6, Black teaches (FIG. 5A) that one of more biometric sample is registered.

Re claim 7, the Examiner notes it would have been obvious that different samples (from different people) would be associated with different information from those others who are registered in the system, to provide a system usable by more than one person, as is conventional in the art.

Re claims 9 and 10, the Examiner notes that as different samples will be present from different users, the Examiner notes it would have been obvious that the multiple samples are associated with such different information (accounts), in order to comply with the security of having a multiple user system. In addition, in instances where the same users have different

samples, such means are well known in the art to provide enhanced security levels (as discussed in previous action with respect to Baer, for example).

Re claim 10 and 11, as discussed above, it would have been obvious to one of ordinary skill in the art to associate different samples with different information in instances where there are multiple users of the system, for unique identification.

Re claim 12, it is interpreted by the Examiner that Black authenticates a user by the biometric sample and signature matching. This is interpreted as a secondary security feature. Additionally, the Examiner notes that secondary security features are well known and conventional in the art to verify that a sample is real (not fake) to increase security (for example, temperate or blood flow sensing).

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes that de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013]).

Re claim 14, the Examiner notes that it has been taught above and in the previous Office Action that the same is received at one of a local database, remote database, portable storage device, host system, etc. as recited in the claim.

Re claim 15, a fingerprint scan has been discussed above (see Black for example).

Re claims 18 and 20, the Examiner notes that Hohle et al. teaches such limitations regarding a room key (EF 910) and user preferences as claimed (FIG. 4).

Re claim 21, the Examiner notes that it is conventional in the art to associate a limit (maximum amount for a charge card) for security/safety. Therefore such limitations are an obvious expedient.

4. Claims 8, 9, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hohle et al., as discussed above, in view of de Sylva.

The teachings of Black/Hohle et al. have been discussed above.

Black/Hohle et al. are silent to primary and secondary association as claimed.

De Sylva teaches such limitations (record 30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hohle et al. with those of de Sylva for convenience of the user, by setting primary and secondary accounts based on user preferences.

Re claim 9, the limitations have been discussed above re claim 8, where different users have different samples associated. Additionally, as discussed above, it would have been obvious to use different samples of users for different types of transactions, where the samples are from the same user, for security.

Re claim 16, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

Re claim 21, it is obvious to one of ordinary skill in the art to have a preset limit associated with the biometric, such as indirect association (credit card maximum charge amount), for security/safety.

5. Claims 8, 9, 16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hohle et al., as discussed above, in view of Moebs et al. (US 2005/0065872).

The teachings of Black/Hohle et al. have been discussed above.

Black/Hohle et al. are silent to primary and secondary association as claimed.

Moebs et al. teaches such limitations (paragraph [0071]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hohle et al. with those of Moebs et al., for overdraft protection.

Re claim 9, the limitations have been discussed above re claim 8, where it is understood that different users have different samples associated. Additionally, it has been discussed above, that it would have been obvious to have different samples of users for different types of transactions, where the samples are from the same user, for security.

Re claim 16, the Examiner notes that it is well known and conventional that credit cards can have associated limits/line of credits. It would have been obvious to associate the biometric with the limit, via extension, as it is used in conjunction with the card having a limit. One would have been motivated to do this to maintain the protection of the card (credit limit).

Re claim 21, the Examiner notes that as charge levels are assigned to accounts based on price that is interpreted as a maximum transaction amount. Additionally, maximum amounts (credit lines) are conventionally associated with credit cards for user protection.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black/Hohle et al., as discussed above, in view of Jensen et al. (US 2005/0165684).

The teachings of Black/Hohle et al. have been discussed above.

Black/Hohle et al. are silent to secondary security procedure.

Jensen et al. teaches such limitations (paragraph [0081]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black/Hohle et al. with those of Jensen et al.

One would have been motivated to do this for security.

Additional Remarks

7. The Examiner notes that it is well known in the art that different biometrics can be used such as fingerprint, iris, retina, voice, smellprint, etc. as is known in the art (see Mann et al.) Additionally, the Examiner notes that the language of the Hohle et al. reference appears very similar to the claimed file structures of the current claims.

Response to Arguments

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. New prior art has been cited above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see attached PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
9-27-06

DANIEL WALSH
PRIMARY EXAMINER